

PATENT



Docket No. 845-002

AF/ZFW
/3727

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Kuighadush
Serial No. : 09/669,245
Filed : September 25, 2000
For : RETRACTABLE STRAW FOR DRINKING CONTAINERS

CERTIFICATE OF MAILING (37 C.F.R. 1.8a)

Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the attached Response to Notice of Non-Compliant Amendment, Appeal Brief, and Return Postcard along with any paper(s) referred to as being attached or enclosed and this Certificate of Mailing are being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to the: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Respectfully submitted,

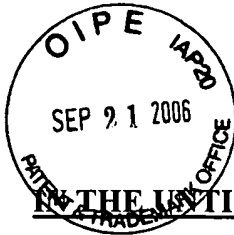
SOFER & HAROUN, L.L.P.

By: 
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Date: September 18, 2006

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Attorney Docket No. 845-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of
Kuighadush

Examiner: Moy
Cronin

Serial No: 09/669,245

Art unit: 3727

Filed: September 25, 2000

For: RETRACTABLE STRAW FOR DRINKING CONTAINERS

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RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

SIR:

In connection with the above-referenced application, please enter this response in Reply to the Notice of Non-Compliant Appeal Brief dated July 28, 2006. In the Notice, the Examiner indicated that Brief is not compliant with 37 CFR 41.37(c)(1)(v) because each there is not complete analysis of the elements for independent claims 15, 22 and 26, including references to the specification and figures.

Appellant hereby submits the attached modified Appeal Brief, including a revised section for 37 CFR 41.37(c)(1)(v) including a summary of claims 15, 22 and 26 and an analysis of the elements with references to the specification and drawings.

Application No. 09/669,245
Response dated September 15, 2006
Reply to Notice dated August 22, 2006

If the Examiner requires any additional material or has any questions they may contact
the undersigned at the number listed below.

Respectfully submitted,

SOFER & HAROUN, L.L.P.

By 

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Dated: September 15, 2006



Attorney Docket No.: 845-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of
Kuighadush

Examiner: Moy
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Serial No: 09/669,245

Art unit: 3727

Filed: September 25, 2000

For: RETRACTABLE STRAW FOR DRINKING CONTAINERS

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APPEAL BRIEF

Mail Stop Appeals

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

In response to the Notice of Non-Compliant Appeal Brief dated August 22, 2006 please enter the following corrected Appeal Brief to be submitted to the Patent Board of Appeals and Interferences pursuant to the pending Appeal.

Application No. 09/669,245

Appeal Brief Dated July 24, 2006

In Response to Notice of Non-Compliant Appeal Brief Dated June 27, 2006

Real Party in Interest 37 CFR 41.37(c)(1)(i)

The real party in interest is Mr. Danny Kuighadush.

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In Response to Notice of Non-Compliant Appeal Brief Dated June 27, 2006

Related Appeals and Interferences 37 CFR 41.37(c)(1)(ii)

The Appellant is not aware of any related prior or pending appeals or interferences related to this matter.

Status of Claims 37 CFR 41.37(c)(1)(iii)

Claims 15, 16 and 20-29 are the pending claims in the application and are the claims on appeal.

Claim 15, 16 and 20-29 are all under final rejection as of the Office action dated December 2, 2003, as containing new matter not originally disclosed in the specification as filed. The Advisory Action of July 7, 2004 repeats this same rejection.

Appellants note that claims 15, 16 and 20 were previously rejected under 35 U.S.C. § 102(b) as being anticipated by any one of Pugh, (U.S. Patent No. 3,071,303), Wen (U.S. Patent No. 5,482,202) or Cornell (U.S. Patent No. 6,076,729). Although Appellants amended the claims and presented reasons for patentability over these references, the amendments to the claims were rejected as containing new matter. The status of these 35 USC § 102(b) rejections is unknown as they are not repeated in the last Office Action containing the new matter rejection. In any event, Appellant is appealing both the new matter rejection and the rejections of the claims in view of the prior art.

A copy of the Claims on Appeal is attached hereto in the Appendix of Claims (Appendix I), listing the current status of pending claims 15, 16 and 20-29 as well as the status of now cancelled claims 1-14 and 17-19. No amendments to the claims are made with this Appeal.

Status of Amendments 37 CFR 41.37(c)(1)(iv)

This application was originally filed on September 25, 2000 with 19 claims. A Restriction Requirement was issued on June 13, 2001 dividing the application into ten different patentably distinct species, based on the Figures. In response, on October 15, 2001, Appellant elected to prosecute species eight (8), namely the claims 15 and 16 directed to Figures 9a and 9b. At the same time, Appellant added a new dependent claim 20, also directed to Figures 9a and 9b.

On October 31, 2001, Appellant received the first Office Action on the merits. Claims 15, 16 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by any one of Pugh (U.S. Patent No. 3,071,303), Wen (U.S. Patent No. 5,482,202), or Cornell (U.S. Patent No. 6,076,729). In response, Appellant filed an Amendment on April 30, 2002, amending claims 15 and 16 and adding new claim 21. These amendments were directed at overcoming the cited references. Support for the amendments was taken from Figs. 9a and 9b and page 10 of the specification as filed.

A second and Final Office Action was issued on July 29, 2002. In the Office Action, the Examiner did not address the substantive rejections under 35 U.S.C. § 102(b) but rather rejected independent claim 15 as well as dependent claims 16, 20 and 21 under 35 U.S.C. § 112 for containing new matter not described in the specification as filed.

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On October 29, 2002, Appellant submitted a reply to the Office Action, without amending the claims, arguing that the language of claims 15, 16, 20 and 21 is supported by the specification as filed. On November 14, 2002, the Examiner issued an Advisory Action, repeating the rejection, and indicating the October 29, 2002 response was insufficient to remove the rejections.

In response to the Advisory Action, Appellant submitted another Amendment dated January 29, 2003, again amending claims 15 and adding new claims 22-29 of which claims 22 and 26 are independent. In the comments, Appellant again argued that the subject matter in amended claim 15, as well as added independent claims 22 and 26, is in fact supported by Figs. 9a, 9b and page 10 of the specification as filed. An RCE was filed with the Amendment to continue prosecution.

On March 10, 2003, the Examiner rejected all claims 15, 16 and 20-29 under 35 U.S.C. § 112. Here, the new matter rejection of claim 15 was carried over and added to new independent claims 22 and 26. The Examiner in this Office Action again reiterated the rejection under 35 U.S.C. § 102 but did not cite to any specific examples as to where the prior art showed the elements of the claims nor did the Examiner indicate the specific grounds for the rejection of the newly added independent claims 22 and 26.

In response on September 10, 2003, Appellants filed another response to the Examiner. Again, Appellants argued on both law and fact that the language of claims 15, 22 and 26 is in fact supported by the specification as filed. To this end, the Appellants

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further filed the Declarations of three separate experts under 37 CFR 1.132, each of

whom stated that Figures 9a and 9b do in fact support the language of the claims. In

addition to these arguments, because the Examiner re-asserted the prior art rejection,

Appellants again argued that the claims include limitations that are not found in the three cited references.

A second Final Office Action was mailed on December 2, 2003. Here the Examiner continued the new matter rejection. However, in his remarks, the Examiner did not in any way address the Appellant's remarks from the prior Amendment nor did he make any statements with regards to the three expert declarations. Appellants do note that the prior art substantive rejection was not repeated here, in either a positive or negative way.

In response, Appellants filed yet another response on April 30, 2004, without amending the claims, arguing that the specification supports the pending claim language. In this response, Appellant's arguments focused primarily on the fact the Examiner did not consider the declarations of the experts. Also included were additional arguments that the claim language was fully supported by the specification as filed.

On July 7, 2004, the Examiner issued an Advisory Action which simply stated that the claims remained rejected for containing new matter.

The due date for filing the Notice of Appeal passed as a result of a docketing

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error. Appellant filed a Petition for Reviving an Unintentionally Abandoned Application.

This Petition was granted on June 3, 2005, and this Appeal Brief is filed according to the

time period set by the Decision on Petition along with a Petition for a One-Month

Extension of Time.

Summary of Claimed Subject Matter 37 CFR 41.37(c)(1)(v)

The present invention relates generally to the area of drinking containers with attached straws. Such containers are commonly used for their convenience, particularly for use with children's drinks and disposable travel lunch drinks such as juice containers. The present invention is an improvement to such containers.

Specifically, the present invention as claimed in claim 15 is directed to a cap assembly comprised of a container (element 70; page 10, line 21 and Figures 9A and 9B) having a plurality of sides (Figures 9A and 9B) and an opening disposed on a top portion of the container. The opening (shown in both Figures 9A and 9B) is disposed at the top of a first one of the plurality of side walls, where the opening is covered by a cap (element 60; line 22, page 10 and Figures 9A and 9B) positionable in an opened (Figure 9B) and closed position (Figure 9A). An extendable straw (element 62; line 22, page 10 and Figures (9A and 9B) is provided having upper and lower portions (shown in both Figures 9A and 9B). The lower portion extends downwardly against the first side wall (See Figures 9A and 9B), and the upper portion is coupled with an inner side of the cap (See Figures 9A and 9B and line 22 of page 10) so that when the cap is in an opened position, the straw is available at the opening for use (See Figure 9B).

The present invention further claims in independent claim 22 where the configuration between the upper and lower portions of the straw are such that the pleats (element 64 in Figures 9A and 9B) are required to allow and unimpeded flow of liquid that passes through said straw (See line 23 of page 10 and Figures 9A and 9B).

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The present invention further claims in independent claims 26 where the lower portion is disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall (See both Figures 9A and 9B).

The present invention further claims, in claims 16, 24 and 28, that the straw further comprises pleats, disposed between the upper portion of the straw located on the cap and the second lower portion disposed along the first side wall, so that the straw can bend over a base of the scored finger portion.

The present invention further claims in claims 20, 23 and 27 that the cap is a scored finger portion and in claims 21, 25 and 29 it is further claimed that a top opening of the straw is disposed co-planar with a top side of the scored finger portion.

The relevant portions of the application that support the elements of the claims is found in Figs. 9a and 9b as well as lines 19-23 of page 10 of the specification.

Grounds of Rejection to be Reviewed on Appeal 37 CFR 41.37(c)(1)(vi)

There are two distinct issues on appeal. The first issue is whether or not the language contained in claims 15, 16 and 20-29 are supported by the specification as filed. Claims 15, 16 and 20-29 have been either amended or added since the filing of the application. The Examiner asserts that the amended claims and the new claims contain subject matter that was not disclosed in the application as filed and has thus rejected the claims under the first paragraph of 35 U.S.C. § 112. Appellant asserts to the contrary that Figs. 9a and 9b as well as page 10 of the specification as originally filed do support all of the elements of the claims. As an ancillary issue, Appellant, as discussed below, submitted the Declaration from three separate experts to support Appellant positions. Appellants request that these Declarations be considered by the Board as they do not appear to have been given any weight by the Examiner.

The second issue on appeal is that, assuming the claims do not contain new matter, then, as they stand currently, the claims of the present invention are both novel and non-obvious in view of the cited prior art references currently on file.

Arguments 37 CFR 41.37(c)(1)(vii)

Issue of New Matter

As noted above the issue of a new matter rejection was first raised in response to the Amendment dated April 30, 2002 when independent claim 15 was first amended. The new matter rejection was expanded in response to the January 29, 2003 Amendment where claim 15 was amended a second time and new independent claims 22 and 26 were added.

Appellant respectfully asserts that the specification as filed does fully support the claims in their current pending form and that all of the Examiner's new matter rejections under 35 U.S.C. § 112 are in error.

The gravamen of the issue raised by the Examiner is that certain elements of the claims are not supported or enabled by the specification as filed. In particular, the Examiner contends that certain elements of the independent claims, namely claims 15, 22 and 26 are not supported in the specification as filed.

In claim 15, the Examiner contends that the un-supported element is:

“where said lower portion extends downwardly against said first side wall”

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In claim 22, the Examiner contends that the un-supported element is:

“said upper portion, coupled with an inner side of said cap, and said lower portion are connected by pleats, wherein the configuration between the upper and lower portions of the straw are such that the pleats are required to allow an unimpeded flow of liquid that passes through said straw”

It is assumed that the upper portion being attached to the cap and the pleated connection are not in dispute as these portions are specifically mentioned in the specification on page 10, lines 21-23 state that the carton has a “scored finger portion 60 that can be pulled open to expose straw 62 that is attached to the underside of finger 60. Straw 62 has pleats 64 that allow it to bend without impeding the flow of liquid.” As such, the Examiner’s dispute must be with the element of claim 22, which recites the configuration between the upper and lower portions of the straw are such that the pleats are required to allow an unimpeded flow of liquid that passes through the straw.

In claim 26, the Examiner contends that the un-supported element is:

“said lower portion is disposed along said first side wall, parallel to both the edges of and the plane of said first side wall”

The arguments issued by the Examiner in the last Office Action of December 2, 2003 and confirmed by the issuing of the final Advisory Action, state that claims 15-16 and 20-29 are rejected under the first paragraph of 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was

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filed, had possession of the claimed invention.

Specifically, the Examiner is contending that the Appellant's arguments that have been filed throughout the prosecution of the application were fully considered but are not persuasive. He states in the December 2, 2003 Office Action:

"Figures 9A and 9B only show interrupted lines to indicate a straw is located inside the container. They do not show the specific orientation of the lower portion of the straw as claimed. There is on [sic] further description in the specification to further detail the specific orientation as claimed. Applicant only speculates what that dotter[sic] lines in the drawing may do. Any claimed specific arrangement of the straw inside the container is considered as new matter."

Appellant notes that this rejection was originally raised in the November 14, 2002 Advisory Action and again in the Office Action dated March 10, 2003. In the Amendment of September 10, 2003, Appellant responded, but the Examiner stated that the arguments were unpersuasive.

Appellants disagree with the Examiner's assessments for the following reasons:

Regarding Claims 15 and 26

In these claims the elements presented are:

"where said lower portion extends downwardly against said first side wall" (claim 15)

and

"said lower portion is disposed along said first side wall, parallel to both the edges of and the plane of said first side wall" (claim 26)

The Examiner has rejected these elements as not being properly supported by the

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specification. In this instance, Appellant asserts that the text of the specification partially supports these elements, and they are completely supported when viewing the specification and figures together.

In independent claim 15, a straw is claimed in conjunction with a container, where the straw is claimed as an extendable straw, having upper and lower portions, where *the lower portion extends downwardly against said first side wall*. Appellant submits that this element is in fact supported in the specification as filed.

The relevant portions of the application that support the elements of claim 15 are found in Figs. 9A and 9B as well as lines 19-23 of page 10 of the specification. A copy of Figs. 9a and 9b are attached as Appendix II.

Specifically, the lower portion of the straw, extending downwardly along the first side wall of the container, is adequately supported in the specification by the drawings in Figs. 9A and 9B which clearly illustrate this arrangement. It is evident from Figs. 9A and 9B that that lower portion of the straw is clearly shown to *extend downwardly along the side wall*.

Previously, the Examiner had argued that because the figures show the lower portion of the straw is shown in “interrupted lines,” they are intended to merely broadly convey location within the container, rather than illustrate a specific location along the first side wall. Such an interpretation by the Examiner however, is not in accordance with a standard interpretation of these figures by one of ordinary skill in the art. Those familiar with technical drawings in this field, and of ordinary skill in the art, readily associate the drawings of lower portion of the straw in dashed lines in Figs. 9A and 9B to indicate that the straw extends downwardly against the first side wall, but that it is simply

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not visible from the outside of the container.

In support of this contention, Appellant has previously submitted Declarations from three independent individuals, of ordinary skill in the art, who have reviewed Figs. 9A and 9B and have indicated that the relevant drawings unambiguously indicate that the lower portion of the straw does in fact *extend downwardly along the side wall*.

A first Declaration under 37 CFR 1.132, submitted herewith as Appendix III, is by Dr. Sidi Berri, a mechanical engineering professor. A second Declaration under 37 CFR 1.132, submitted herewith as Appendix IV, is by Mr. Jacob Cohen, an owner of a plastic straw manufacturing company. A third Declaration under 37 CFR 1.132, submitted herewith as Appendix V, is by Mr. Daniel Kamel, an architectural designer.

An Applicant may submit factual affidavits under 37 CFR 1.132 to show what one skilled in the art would understand by reading the disclosure, as was done in this case. A declaration or affidavit is itself, evidence *that must be considered*. See MPEP § 2164.05 and *In re Alton* 76 F.3d 1168, 1174, 37 USPQ2d 1578, 1583 (Fed. Cir 1996). In the response of September 10, 2003, Appellant submitted such declarations.

In each of the three cases, the Declarants, all of ordinary skill in the art, have indicated, that Figs. 9A and 9B of the application clearly show that the straw is attached to the inner first side wall of the container. Their assertions rest on their knowledge and experiences with technical drawings. *They note that their conclusions were reached because the dotted lines, depicting the straw, extends in parallel with both sides of the surface of the wall the straw extends along, and do not exhibit any ambiguity.* They each have independently concluded that the figures clearly illustrate a straw that extends against the first side wall of the container.

Furthermore, the Declarants go on to state that their conclusions, about Figs. 9A and 9B, are even more apparent from Figs. 8A and 8B, where the straw is depicted as a straw, floating within the container using the same dashed lines. *They note that in contrast with Figs 9A and 9B, the dotted lines representing the straw are not parallel with any of the sides of the surface of the walls of the container. Thus, they conclude that Figs. 8A and 8B show that the straw is floating, whereas Figs. 9A and 9B show that the straw is along the first side wall.*

As discussed in prior Amendments, Appellant notes that the Court of Appeals for the Federal Circuit has recognized that, “drawings alone may provide a ‘written description’ of an invention as required by §112.” See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1565, 19 USPQ 2d 1111, 1117 (Fed. Cir. 1991); See also In re Heinle, 145 USPQ 131 (CCPA 1965) (Where the court stated that it is proper to include matter that is clearly and conclusively disclosed by the drawings. Were the drawings appear to conform to the one-fourth circumference limitation, it is possible to amend the application to include the one-fourth limitation without violating the rule against “new matter”.)

Appellant is also aware that the statements made in such declarations must be more than conclusory. However, each of the declarants made specific reasoned statements, not only that Figs. 9A and 9B supported the language of claims 15 and 26, *but also gave specific reasons why they reached their conclusion as well*, as discussed below. See In re Buchner 929 F.2d 660, 661 18 USPQ2d 1331, 1331 (Fed. Cir 1991).

In Vas-Cath, Inc., the Court specifically relied on evidence presented in a Declaration confirming that the drawings did in fact convey to one of ordinary skill in the

art the necessary support for the claimed language. In further support of their decision,

the Court cited to the lack of any evidence, to indicate how one of ordinary skill in the art could interpret the drawings to the contrary of that presented in the Declaration. *See Id at 1566-1567.*

Further in support of Appellant's position that Figs. 9a and 9b support the language of claim 15 is that the description of other figures within the specification are consistent with Appellant's interpretation.

For example, in addition, the specification on page 11 a pouch is described as, "sealed to the inside of container 70" and, "a ripple 92 in pouch 66 forms a straw that can be accessed through scored finger 60." This description is related to Fig. 10C, showing such a pouch in a similar container to one claimed in the presently pending claims. It is evident that this pouch is attached to the side wall by virtue of the accompanying description. In the corresponding Fig. 10C, the lower portion of the straw is illustrated as extending downwardly along the side wall, parallel to the plane of and the edges of the side wall. Thus, the showing of the pouch in Fig. 10C with the pouch extending down the side wall is correspondingly described in the specification as being sealed to the inside of the container. In view of these other descriptions of Figures within the application, such as Figures 10C, it is clear that Appellant's arguments in support of Figs. 9A and 9B as supporting the present claim language are consistent with an ordinary reading of the specification as a whole.

As such, it is consistent throughout the rest of the specification as well as corresponding Figures 9A, 9B and 10C to support the claims of the present application.

Turning now to independent claim 26, the Appellant has claimed a straw in

conjunction with a container where lower portion is disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall.

As discussed above, Appellant notes that Figs. 9A and 9B clearly show such an arrangement. Furthermore, the three independent Declarations each states that the dotted lines, depicting the straw, are extended in parallel with both sides of the surface of the wall the straw extends along.

As such, Appellant respectfully submits that Figs. 9A and 9B, as filed provide sufficient support in the specification, for the elements of claims 15 and 26 where the lower portion of the straw extends downwardly along the side wall. Further, Appellant has submitted three independent declarations from individuals of ordinary skill in the art confirming such a conclusion. Thus, Appellant submits that the Examiner's interpretation of the interrupted lines of Figs. 9A and 9B is in error. And, absent any showing in opposition to the submitted Declarations, Applicant requests that the rejection of claims 15 and 26, and the claims that depend therefrom, under 35 U.S.C. § 112, be withdrawn.

Regarding Claim 22

In this claim the element presented is:

“said upper portion, *coupled with an inner side of said cap*, and said lower portion *are connected by pleats*, wherein the configuration between the upper and lower portions of the straw are such *that the pleats are required to allow an unimpeded flow of liquid that passes through said straw*”

The Examiner has rejected this element as not being properly supported by the

Appellant notes that in order to make such a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See MPEP § 2164.04, citing *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).

Furthermore, it is incumbent upon the Examiner, whenever a rejection on this basis is made, to explain why the Examiner doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise there would be no need for the Appellant to go to the trouble and expense of supporting his presumptively accurate disclosure. See MPEP § 6164.04 citing to *In re Marzocchi* 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).

In the present application, Appellant notes above that coupling of the upper portion to the cap and the connecting of the upper and lower portions with pleats is taken directly from the specification as filed.

In fact, the element “*that the pleats are required to allow an unimpeded flow of liquid that passes through said straw*” is a near direct recitation of the specification, page 10, lines 21-23 which states “*Straw 62 has pleats 64 that allow it to bend without impeding the flow of liquid.*”

In the Office Action, the Examiner, rather than issuing any supporting statements as to how he drew his conclusions that the specification does not support this element of

claim 22, instead conclusively states, that Figs. 9A and 9B do not show the orientation

within the container as claimed and that “there is on[sic] further description in the specification what that dotter[sic] lines in the drawings may do.” The first portion of the statement is not applicable to the claim 22 analysis and the second portion of the statement is false as demonstrated above.

Figs. 9A and 9B are not used as the principle support for enabling the elements of claim 22, they merely add to the already completely adequate description on page 10 of the specification. Furthermore, the statement that the specification contains no further description on this point is false, as it clearly does state, “Straw 62 has pleats 64 that allow it to bend without impeding the flow of liquid.”

As such, Appellant can not determine on what basis the Examiner is rejecting claim 22, or the claims that depend therefrom, under the auspices of the first paragraph 35 U.S.C. § 112, as all of the elements of this claim are clearly recited in the text of the specification on page 10. In addition, although this element is shown in Figs. 9A and 9B, it is not necessary for the Appellant to rely solely on these figures for supporting this element of claim 22, when the text alone is support for the element as well.

Therefore, Appellant respectfully submits that the Examiner has failed to make a *prima facie* case for lack of enablement under paragraph 1 of 35 U.S.C. § 112.

Therefore, Appellant respectfully requests that the Examiner’s rejection of claim 22, and the claims that depend therefrom, under 35 U.S.C. § 112 be withdrawn.

Regarding Dependent Claims 16, 20, 21, 23-25 and 27-29

Claims 16, 24 and 28 including the limitations that the pleated separation between

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the upper and lower portions of the straw, are clearly supported in the application as filed.

Figs. 9a and 9b both show the pleated intersection between the upper and lower portions of the straw. Element 64 specifically identifies the pleats. Lines 22 and 23 of page 10 of the specification reads, "Straw 60 has pleats 64 that allow it to bend without impeding the flow of liquid."

Claims 20, 23 and 27 including the limitation that the cap is a scored finger portion, are clearly supported in the application as filed. Figs 9a and 9b both show the scored finger portion cap. In fact, element 60 shown in both figures, specifically identifies the scored finger portion. Lines 21 and 22 of page 10 of the specification reads, "Instead, carton 70 has a scored finger 60 that can be pulled open to expose straw 62 that is attached to the underside of finger 60."

Claims 21, 25 and 29, including the limitation that the top of the straw is co-planar with the top side of the scored finger portion, are clearly supported in the application as filed. Fig 9b shows the top of straw 62 to be co-planar with the top side of the scored finger portion 60.

As such, Appellant respectfully submits that Figs. 9A and 9B, as filed provide sufficient support in the specification, for the elements of claims 16, 20, 21, 23-25 and 27-29 where the lower portion of the straw extends downwardly along the side wall. Further, Appellant has submitted three independent declarations from individuals of ordinary skill in the art confirming such a conclusion.

Issue of Substantive Rejections

As noted above, the question of substantive rejections is unclear as a result of the

new matter rejections. In any event Appellant will treat the claims as being finally

rejected as being anticipated by any one of Pugh, (U.S. Patent No. 3,071,303), Wen (U.S. Patent No. 5,482,202), or Cornell (U.S. Patent No. 6,076,729). Appellants disagree with the Examiner's rejections and request that the Board remove the rejection to these claims.

The present invention is directed to a cap assembly comprising a container and a straw. As claimed in independent claim 15, the lower portion of the straw extends downwardly along the side wall. As claimed in independent claim 22, the upper portion, and the lower portion of the straw are connected by pleats, such that the pleats are required to allow an unimpeded flow of liquid that passes through said straw. As claimed in independent claim 26, the lower portion of the straw is disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall, and extends downwardly along the side wall.

In this configuration the present invention allows a user to tilt the container towards themselves in a comfortable natural position assured that the straw will be located at the bottom of the container relative to the fluid contained therein, without twisting the container in any uncomfortable configurations.

Additionally, the present invention maintains a flexible portion which prevents the bent straw from kinking within the closed container even though the straw is against a single first side of the container. Furthermore, by arranging the top opening of the straw in a fixed co-planar arrangement with the top side of the scored finger portion cap, the user can easily close the container without having to awkwardly maneuver the straw. Also the user is assured that when re-opened, the straw will be easily accessible on the underside of the scored finger portion cap.

On the contrary, the cited prior art does not teach such an arrangement for a lower portion of a straw.

The cited prior art, namely Wen, is directed to a drink box with a built in straw. In Wen, a straw is attached to the inside of drink container, with a lower portion attached to one side of the container and an upper portion attached to a triangular disposable section located at the *opposite* side of the container, such that the triangular portion of the container can be removed pulling the upper portion of the straw out of the container for drinking. The triangular portion is then discarded.

The cited prior art, namely Cornell, is directed to fluid dispensing spout for beverage containers. Cornell is directed to straw disposed within a container, configured to be exposed when a cap portion is opened. In the various embodiments, the straw is freely contained at lower end within the container and the upper end is attached or directed towards a cap region. When the cap is opened, the straw is exposed, unattached to the cap, beyond the top of the cap for the user to drink from.

The cited prior art, namely Pugh, is directed to milk carton with a drinking straw. In Pugh, the straw is attached to a saddle connected to the underside of the cap allowing the straw to be loosely connected to the cap such that when the cap is opened, the saddle pulls the straw out of the container, beyond the end of the cap, so the user may drink from the straw. As illustrated in the Pugh figures, the straw is not connected to the bottom of the container but rather is wedged and bent into place when closed and, when opened, is extended beyond the top of the cap.

Contrary to the Examiner's contention, there is no teaching or suggestion in any of the cited prior art, either alone or in combination with one another, which teaches or

suggests the present invention as claimed. It is evident that the Cornell reference makes no showing of a lower portion of straw posited along a side wall. Furthermore, the Wen reference only shows attachment of the lower portion of the straw to the *opposite* side of the container. Such arrangements do not confer the advantages of the present invention discussed above.

As the cited prior art does not teach or suggest the present invention as claimed in the independent claim 15. For example, there is no teaching or suggestion in either Wen, Cornell or Pugh that discloses a lower portion of straw extending downwardly along a first sidewall. Dependent claims 16, 20 and 21, which depend therefrom, are allowable for the same reason.

Likewise, the cited prior art does not teach or suggest the present invention as claimed in the independent claim 22. For example, there is no teaching or suggestion in either Wen, Pugh or Cornell that discloses an upper portion lower portion of a straw connected by pleats, *such that the pleats are required* to allow an unimpeded flow of liquid that passes through said straw. In Wen the pleats are not required for unimpeded flow between the upper and lower portions of the straw because the lower portion is attached to the opposite side of the container. In Cornell the pleats are unnecessary because the lower portion of the straw is free to move about the inside of the container. Dependent claims 23-25, which depend therefrom, are allowable for the same reason.

Furthermore, the cited prior art does not teach or suggest the present invention as claimed in the independent claim 26. For example, there is no teaching or suggestion in either Wen, Pugh or Cornell that discloses a lower portion of a straw disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall. Dependent

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claims 27-29, which depend therefrom, are allowable for the same reason.

As such, Appellant respectfully requests that the substantive rejections of independent claims 15, 22 and 26 under 35 U.S.C. § 102(b) be withdrawn.

Claims Appendix (37 CFR 41.37(c)(1)(viii))

1-14. (cancelled)

15. (rejected) A cap assembly, comprising:

a container having a plurality of sides and an opening disposed on a top portion of said container, said opening disposed at the top of a first one of said plurality of side walls, said opening covered by a cap positionable in an opened and closed position; and

an extendable straw, said straw having upper and lower portions, where said lower portion extends downwardly against said first side wall, and wherein said upper portion is coupled with an inner side of said cap so that when said cap is in an opened position, said straw is available at said opening for use.

16. (rejected) A cap assembly as set forth in claim 20, said straw further comprising pleats disposed between said upper portion of said straw located on said cap and said second lower portion disposed along said first side wall so that said straw can bend over a base of said scored finger portion.

17-19. (cancelled)

20. (rejected) A cap assembly as set forth in claim 15, wherein said cap is a

21. (rejected) A cap assembly as set forth in claim 20 wherein a top opening of said straw is disposed co-planar with a top side of said scored finger portion.

22. (rejected) A cap assembly, comprising:
a container having a plurality of sides and an opening disposed on a top portion of said container, said opening disposed at the top of a first one of said plurality of side walls, said opening covered by a cap positionable in an opened and closed position; and

an extendable straw, said straw having upper and lower portions, where said upper portion, coupled with an inner side of said cap, and said lower portion are connected by pleats, wherein the configuration between the upper and lower portions of the straw are such that the pleats are required to allow an unimpeded flow of liquid that passes through said straw and are further configured such that when said cap is in an opened position, said straw is available at said opening for use.

23. (rejected) A cap assembly as set forth in claim 22, wherein said cap is a scored finger portion.

24. (rejected) A cap assembly as set forth in claim 23, wherein said pleats, disposed between said upper portion of said straw located on said cap and said second lower portion disposed along said first side wall, are configured such that said straw can

25. (rejected) A cap assembly as set forth in claim 23 wherein a top opening of said straw is disposed co-planar with a top side of said scored finger portion.

26. (rejected) A cap assembly, comprising:
a container having a plurality of sides and an opening disposed on a top portion of said container, said opening disposed at the top of a first one of said plurality of side walls, said opening covered by a cap positionable in an opened and closed position; and

an extendable straw, said straw having upper and lower portions, where said lower portion is disposed along said first side wall, parallel to both the edges of and the plane of said first sidewall, and wherein said upper portion is coupled with an inner side of said cap so that when said cap is in an opened position, said straw is available at said opening for use.

27. (rejected) A cap assembly as set forth in claim 26, wherein said cap is a scored finger portion.

28. (rejected) A cap assembly as set forth in claim 27, said straw further comprising pleats disposed between said upper portion of said straw located on said cap and said second lower portion disposed along said first side wall so that said straw can bend over a base of said scored finger portion.

29. (rejected) A cap assembly as set forth in claim 27 wherein a top opening of said straw is disposed co-planar with a top side of said scored finger portion.

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Evidence Appendix (37 CFR 41.37(c)(1)(ix))

There is no additional material for this section.

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Related Proceedings Appendix (37 CFR 41.37(c)(1)(x))

There is no additional material for this section

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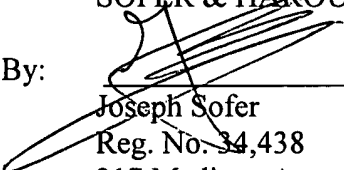
Appellant respectfully submits that the present invention as claimed is now in condition for allowance, and requests that the Patent Board of Appeals reverses the rejections of the Examiner and remands it to him for further prosecution as requested by Appellant.

Respectfully submitted

SOFER & HARCUN, LLP

Dated: 9/15/06

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